

REMARKS

Claims 1-15 stand rejected. Claims 1, 2, 4-6, and 8-11 are amended, and claim 3 is canceled; therefore, after entry of this amendment, claims 1, 2, and 4-15 will be pending. Claim 1 is amended to more particularly point out the invention. Support for this amendment is found in Fig. 1B and the associated text, and in originally filed claim 3, which has been cancelled. Claims 2 and 6 have been amended to comport with antecedent basis provided in amended claim 1. Claims 4 and 5 have been amended to correct dependency. Claims 8 and 10 have been amended to more particularly point out a feature of an embodiment of the invention. Support for these amendments is found in the written description in paragraphs [0021] and [0022]. Claim 9 has been amended to correct antecedent basis. Claim 11 has been amended to more particularly point out the invention. No new matter has been added.

Rejections under 35 U.S.C. § 103

Claims 1, 7-8, 11 and 13-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,155,474 by Park et al. ("Park") in view of U.S. Patent No. 4, 943,799 by Papineau ("Papineau"). The Examiner cites Park for disclosing the claimed portable motion-sensing light, including an electrical power plug ("mains plug" 58, Fig. 2 of Park). The Examiner states that it would have been obvious to modify the photographic security system disclosed in Park according to the disclosure in Papineau. The Applicant respectfully traverses the Examiner's position.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Claim 1, as amended, recites, among other elements, a portable motion-sensing light having a power cord with an electrical plug on one end and a second end of the power cord entering the sealed housing at a power cord entry. In other words, the electrical cord is integrated with the portable motion-sensing light. Papineau discloses using a terminal connector with a power cord 31 having opposed electrical end plugs 34', 35'. The power cord 31 does not enter the housing. The Applicant also notes that the mains plug 58 shown in Fig. 2 of Park is not the housing 16 indicated by the Examiner, but on the camera

housing 30.

Amended claim 1 recites a control circuit inside the sealed housing. The Examiner states that reference numeral 16 in Fig. 1 of Park is the housing. Fig. 2 of Park shows a logic control board 66 in the camera housing 30. The control circuit recited in claim 1 is not in the housing 16 indicated by the Examiner. Thus, all elements of amended claim 1 are not disclosed in the cited art.

In order to establish a *prima facie* case of obviousness, the Examiner must set forth the proposed modification of the reference that would be necessary to arrive at the claimed subject matter. A prior art reference must be considered in its entirety, *i.e.* as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Park discloses a motion-sensing photographic security system intended to be attached to a wall (Col. 4, line 21) with a wall mounting plate (16) and brackets (36), and does not appear to be a portable motion-sensing light as recited in claim 1. Park provides for adjustment of the camera within the camera housing 30 (Col. 4, lines 51-63). It appears that accurate, secure alignment of the camera to an opening through which an unauthorized intruder might be expected to gain entry (Col. 2, line 56-59) is an important feature of the photographic security system of Park. Considering Park as a whole, it teaches away from the claimed portable motion-sensing light.

Before combining the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so. *In re Jones*, 958 F.2d 347, (Fed. Cir. 1992). The mere fact that prior art may be modified to reflect features of the claimed invention does not make motivation, and hence the claimed invention, obvious unless the desirability of such modification is suggested by the prior art. *In re Fritch* 23 USPQ.2d 1780 (Fed. Cir. 1992) (*emphasis added*). The Examiner states that, in view of the teachings by Park and Papineau, it would have been obvious when mounting a device such as taught by Park to a wall surface that is displaced from an available electrical outlet socket, a conventional power cord, such as the one used by Papineau, can be used by the mains plug for connection to the outlet socket for providing

AC power. However, neither reference provides the necessary suggestion or desirability for the proposed modification of Park. Each reference appears to provide a complete and operative product without need for the Examiner's proposed modification. Accordingly, the Applicant believes claim 1 and all claims that depend from claim 1 are allowable, and that claims 9 and 10 are allowable for at least similar reasons.

Amended claim 8, which depends from claim 1 through claim 7, recites a means for mounting on the back of the sealed housing configured to removably couple to a mating member disposed on a mounting support. As taught in the written description in paragraphs [0021], [0022] and [0030], such a feature allows the light to be quickly and easily removed and re-installed, and allows the light to be mounted in a selected orientation, or allows a single light to be moved between a number of brackets. As discussed above in support of claim 1, the photographic security system of Park appears to be intended to be securely attached to a wall with a wall mounting plate 16 and brackets 36, and teaches away from claim 8. Similarly, the wall mounting plate 16 and brackets 36 of Park are not on the back of the housing, as claimed. The portable alarm system disclosed in Papineau shows a flat bottom wall 21 so that the housing may rest on a support surface, also teaching away from claim 8. Neither reference discloses or suggests means for mounting configured to removably couple to a mating member. Therefore, the Applicant believes claim 8 is further patentable, and that claim 10 is further patentable for similar reasons.

Claim 11, as amended, recites a method of operating a motion-sensing light with an integrated power cord and electrical plug. As discussed above in support of claim 1, the cited art does not disclose or suggest a motion-sensing light with an integrated power cord and electrical plug; therefore, the cited art cannot disclose or suggest the recited method of operation. Accordingly, the Applicant believes claim 11 and all claims that depend from claim 11 are patentable.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al. in view of Papineau, U.S. Patent No. 5,818,338 by Ferraro, and U.S. Patent No. 5,463,595 by Rodhall et al. ("Rodhall"). Claim 4 recites a first housing portion welded to a second housing portion. The Examiner cites Rodhall for disclosing welding

between first and second housing portions. Park discloses a camera **40** inside the camera housing **30**. Welding the camera housing **30** shut would interfere with the removal of the camera for film developing, and with the alignment of the camera inside the camera housing **30**. Using adhesive sealant between the housing portions, as recited in claim 5, would likewise interfere with the removal and alignment of the camera. The Applicant believes that the proposed combination would be inoperative, or change a functional operating characteristic of Park. Therefore, the Applicant believes claims 4 and 5 are further patentable.

Claims 6 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al. in view of Papineau, U.S. Patent No. 5,818,338 by Ferraro, U.S. Patent No. 5,463,595 by Rodhall et al. ("Rodhall"), and U.S. Patent No. 4,890,318 by Crane et al. ("Crane"). Claim 6, which depends from claim 1, further recites closed-cell foam disposed within the sealed housing around at least one of a power cord entry, a sensor wire entry, and a lamp socket wire entry ("wire entry"). In paragraph [0026] the applicant teaches that closed cell foam **50** applied at the wire entry points can provide an enhanced seal as the power cord is pulled or otherwise stressed. The Examiner cites Rodhall for disclosing sealing the power plug entry. As with the AC connecting plug **26** shown in Papineau, it appears that a power cord is intended to be plugged into the socket **26** of Rodhall. The power cord does not enter the housing.

The Examiner cites Crane for disclosing closed cell foam; however, Crane merely discloses using a door **22** with a gasket **69** of closed cell foam. The closed-cell foam is not around a wire entry, as recited in claim 6. None of the cited references disclose or suggest using closed-cell foam around a wire entry into a sealed housing of a portable motion-sensing light. Therefore the Applicant believes claim 6 is further patentable, and that claims 9 and 10 are patentable for at least similar reasons.

Amended claim 10 is believed to be further allowable for the reasons cited above in support of the patentability of claim 8.

Evidence Rebutting Obviousness

The Applicant believes no *prima facie* case of obviousness exists for the reasons given above. However, if the Examiner does not agree with the Applicant's position, the Applicant respectfully requests consideration of the secondary factors supporting a conclusion of non-obviousness and facts provided by the attached Declarations Under 37 C.F.R § 1.132.

The Declaration of Tena Youngblood (the Applicant) provides evidence of commercial success arising from the claimed features of her invention. Her declaration also provides evidence of how she recognized an un-met need and invented a product to meet that need, *i.e.* how she solved an unrecognized problem. Finally, her declaration provides evidence supporting that the field of motion sensing lights is crowded.

As evidenced in Ms. Youngblood's declaration, the invention has been very successful and well received because of the features claimed in the patent application and the benefits obtained by her invention that are not available with conventional motion-sensing lights. The advantages of the claimed portable motion-sensing light, such as avoiding the need to install a utility box and permanent wiring, were not previously appreciated, and were not available with conventional outdoor motion-sensing lights. The undersigned respectfully requests that her recognition of the problem and her creation of a solution to the problem be considered when determining the patentability of her claims in light of the entire record. The Applicant states that she looked at over 100 motion-sensing lights, but did not see any portable motion sensing light for outdoor use. Even a small advance in such a mature and crowded field should further qualify the invention for a patent.

The Declaration of Richard P. Tacla provides further evidence of the desirability of the claimed invention and how it solved an unrecognized problem. In particular, providing an outdoor motion sensing light without having to install wiring, and the ability to easily change the location of the light to optimize its operation.

The Declaration of Irene Krumze provides further evidence of the desirability of a portable motion sensing light according to the claimed invention.

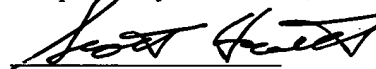
Although the invention may appear simple, it would be improper to deny patent protection sought by the Applicant merely because her invention is simple. To the contrary, the apparent simplicity supports a conclusion of non-obviousness because there are hundreds of motion-sensing lights available for sale, and motion-sensing lights have been around for several years, yet, to the best of the Applicant's knowledge, no one has ever made a motion sensing light as claimed in her patent application.

Conclusion

In view of the foregoing, the Applicant believes all claims pending in this Application are in condition for allowance. The Applicant respectfully requests reconsideration of all pending claims, the withdrawal of all rejections, and the issuance of a formal Notice of Allowance at an early date.

If the Examiner believes this amendment does not put all pending claims in condition for allowance, and believes a telephone conference might expedite prosecution of this matter, the undersigned invites the Examiner to telephone him at (707) 591-0789.

Respectfully submitted,



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